

Application No. 10/630,492

Reply to Office Action

REMARKS

The Office Action of October 4, 2005, advises that claims 1-31 are subject to a restriction requirement. Specifically, claims 1-8 and 15-31 are said to constitute Group I (a nano-porous metal oxide semiconductor and photovoltaic device), while claims 9-14 are said to constitute Group II (a method of making a nano-porous metal oxide semiconductor). The Office Action advises that, because of the purported divergent claimed subject matter set forth in Groups I and II, a search must be undertaken in different classes.

Applicants respectfully traverse the restriction requirement. There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (M.P.E.P. § 803).

In this case, the Office fails to meet the required criteria. The Office has not alleged that there would be a serious burden on the Examiner if restriction or election of species were not required. Although the inventions of Groups I and II may be patentably distinct, applicants submit that the Examiner would not be unduly burdened in his search for prior art relevant to each group due to the overlapping nature of the subject matter claimed therein. For example, a complete search for prior art relevant to a process for making a nano-porous metal oxide semiconductor may require a search into prior art relevant to the semiconductors *per se*. For these reasons, withdrawal of the restriction requirement is respectfully requested.

If the restriction is made final, however, Applicants provisionally elect the claims of Group I (claims 1-8 and 15-31) for prosecution at this time.

Conclusion

As applicant believes the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Application No. 10/630,492

Reply to Office Action

Respectfully submitted,



Christopher T. Griffith, Reg. No. 33,392
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: October 21, 2005